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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,857	12/01/2000	Gary W. Kwong	56208USA8A	4252

32692 7590 01/23/2006

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ST. PAUL, MN 55133-3427

EXAMINER
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JUSKA, CHERYL ANN

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 01/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/728,857

Applicant(s)

KWONG ET AL.

Examiner

Cheryl Juska

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 56-66 and 68-81 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 56-66 and 68-81 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 56-66, 68-73, and 78-81 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,240,943 issued to Sugawara and US 4,499,233 issued to Tetenbaum in view of US 5,073,442 issued to Knowlton, US 3,632,419 issued to Horie, and US 5,770,656 issued to Pechhold for the reasons of record.
3. Claims 74 and 75 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Sugawara, Tetenbaum, Knowlton, Horie, and Pechhold references and in further view of US 5,370,919 issued to Fieuws et al. for the reasons of record.
4. Claim 76 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Sugawara, Tetenbaum, Knowlton, Horie, and Pechhold references and in further view of US 3,493,424 issued to Mohrlök et al. for the reasons of record.
5. Claim 77 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Sugawara, Tetenbaum, Knowlton, Horie, and Pechhold references and in further view of US 4,007,305 issued to Kakar et al. for the reasons of record.

***Response to Arguments***

6. Applicant's arguments filed on November 10, 2005, have been fully considered but they are not persuasive. It is noted that applicant has not amended the claims in an attempt to overcome the prior art rejections.

7. Applicant asserts the rejections of record are "redundant" and "inappropriate" and constitute "piecemeal prosecution" (Remarks, page 2, 1<sup>st</sup> and 2<sup>nd</sup> paragraph). The examiner respectfully disagrees. No new references were added in the last Office Action and said rejections of record are proper.

8. Applicant argues that there is no assurance that the Sugawara urethanes would meet the HLB values presently claimed (Remarks, paragraph spanning pages 2-3). In response, the rejection is not based upon Sugawara alone, but rather in combination with other references. It is argued that the Sugawara urethane when modified by the teachings of Tetenbaum would possess the claimed HLB values. Applicant has not shown any evidence to the contrary.

9. Applicant also continues to argue the utility of the long chain alcohol (i.e., capping agent versus water repellency and anti-soiling) (Remarks, page 3, 1<sup>st</sup> paragraph). As stated in the last Office Action, section 10, the claims do not limit the intended use or function of said alcohol. Rather, the claim states a urethane comprising the reaction product of a long chain alcohol. The teachings of the prior art meet this limitation. Contrary to applicant's statement that the examiner is suggesting the claim recite functional language of the alcohol (Remarks, page 3, 1<sup>st</sup> paragraph), the examiner is merely pointing out that the scope of the claim is encompassed by the cited prior art.

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10. Applicant also continues to argue that the Knowlton, Horie, and Pechhold references do not teach the stainblockers can be used with a urethane composition (Remarks, paragraph spanning pages 3-4). As noted in the last Office Action, section 11, the suggestion to combine these references is found in Sugawara's teaching of stainblockers with urethanes. Since Sugawara only teaches stainblockers in general, one must look to the prior art for specific known stainblockers.

11. Applicant also argues there is no motivation to combine the references (Remarks, page 4, 1<sup>st</sup> paragraph). In response, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is reiterated that Sugawara's lack of an explicit teaching for suitable stainblockers motivates one to look to the prior art to find such.

12. In response to applicant's argument that the examiner has combined an excessive number of references (Remarks, page 4, 1<sup>st</sup> paragraph), reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

13. Therefore, applicant's arguments are unpersuasive and the rejections stand.

***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

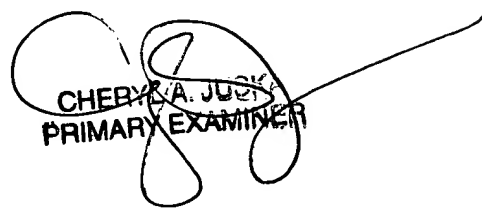
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
CHERYL A. JUCK  
PRIMARY EXAMINER

cj  
January 19, 2006